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10/017,640	12/14/2001	William R. Matz	36968/265387	9378

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Walters & Zimmerman
PO BOX 5743
Williamsburg, VA 23188

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,640

Applicant(s)

MATZ ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-13, 15-22, 32-44, 47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13, 15-22, 32-44, 47 and 48 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20060307</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20060329, 20060117, 20051122, 20051115</u> | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. Claims 4, 14, 23-31, 45, and 46 have been cancelled, and Claims 47 and 48 have been added; therefore, Claims 1-3, 5-13, 15-22, 32-44, 47, and 48 are currently pending in application 10/017,640.

Information Disclosure Statement

2. The information disclosure statement filed 9/20/2005 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

3. Claim 35 is objected to because of the following informalities: line 19 does not correctly address the subject "plurality of programming." Appropriate correction is required by

adding: "the," "a," or "said," before plurality. The Examiner will assume the "plurality of programming" refers to the same "plurality of programming" referred to on line 3 of the claim.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
6. Claim 38 recites the limitation "*the step of analyzing the matched data to determine said probability of the subscriber to purchase said product associated with the advertisement attribute* further comprises analyzing the property ownership history of said subscriber to determine *said probability of the subscriber to purchase said product*" in the method claim 35. There is insufficient antecedent basis for this limitation in the claim.
7. In Claims 35-37, the applicant has amended the claims by deleting the subject matter for determining probability. The Examiner suspects the same amendment was meant for Claim 38. Therefore, the Examiner suggests that the 112 rejection be overcome by applying the same amendment to claim 38, and deleting the probability determination step.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1-2, 6-13, 15-22, 32-44, 47, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Boe et al. (US 6,236,975 B1).**
10. As per **independent Claims 1, 16, and 17**, Boe discloses a method (computer-readable medium, system) for utilizing information relating to a subscriber to identify said subscriber (C3 L23-43, profile generation and target marketing) comprising: receiving data from a plurality of programming (C3 L23-30, Internet survey system – demographic data, survey response, customer requests, customer) and advertising sources (C4 L30-38, business system); receiving subscriber data about a subscriber's use of the programming and advertising sources, the subscriber data comprising: i) a command of interest from the subscriber (Fig.3-4a, C9 L-9-30, Customer accessing business system, accessing survey system, and answering demographic survey questions are all commands of interest); ii) an event record that comprises a command of interest and a time associates with the command of interest (Fig.5a, C9 L23-27, C9 L55-61, answers to demographic survey questions are saved along with time stamp; time stamp necessary to determine last demographic data update); receiving a subscriber attribute (C3 L23-43, survey results and

demographics), the subscriber attribute comprising data about the subscriber (C3 L23-43, survey results and demographics); merging said data from said plurality of programming and advertising sources, said subscriber data, and said subscriber attribute to create a subscriber information data store (C5 L39-54, Matching Database Tables); matching data of said subscriber information data store with an advertisement attribute comprising product data about a product (C6 L47-67, Matching Database/Page Generator); and if data of said subscriber information data store matches an advertisement attribute, then identifying said subscriber as a desirable subscriber to receive a selected advertisement from a provider of said product (C6 L47-67, Matching Database/Page Generator, matches advertisements to customer profile information – equivalent to identifying desirable subscriber to receive a selected advertisement from a provider of said product).

11. As per Claim 2, Boe discloses wherein said subscriber comprises a consumer (Abstract, Customer).
12. As per Claim 6, Boe discloses wherein said subscriber attribute comprises demographic information (C3 L23-28).
13. As per Claim 7, Boe discloses wherein said demographic information comprises a profession of said subscriber (C3 L23-27, income/income level – would offer equivalent demographic matching information).
14. As per Claim 8, Boe discloses wherein said demographic information comprises a property ownership history of said subscriber (Fig.6B, Vehicle).
15. As per Claims 9, Boe discloses wherein said subscriber attribute comprises a questionnaire response (C3 L28-43, Survey response).

16. As per Claim 10, Boe discloses wherein said subscriber attribute comprises a purchase (Fig.4d).
17. As per Claim 11, Boe discloses wherein said purchase comprises a purchase of a product, wherein said product complements a product provided by said provider (C4 L58-60, application for product or service).
18. As per Claim 12, Boe discloses wherein said purchase comprises a purchase of a product, wherein said product competes with a product provided by said provider (Figs.4b-6b, spending history survey results – ex. type of vehicle).
19. As per Claim 13, Boe discloses wherein said provider comprises a content provider (C12 L16-22, business – product or service provider).
20. As per Claims 15, Boe discloses wherein said content provider comprises an advertising provider (C4 L30-40, business system).
21. As per Claim 18, Boe discloses wherein said subscriber attribute database comprises a purchase history database (Figs.4d-4e, C5 L39-54, survey answers, navigation history, application table).
22. As per Claim 19, Boe discloses wherein said purchase history database comprises a credit card database (Figs.4d-4e).
23. As per Claims 20 and 21, Boe discloses wherein said subscriber attribute database comprises a property ownership database or a survey results database (Fig.6b, C5 L39-54, demographics, tables).
24. As per Claim 22, Boe discloses wherein said data analyzer comprises a report creator (C7 L9-27, graphical report generator).

25. As per Claims 43 and 44, Boe discloses communicating (computer code/communications interface) the selected advertisement for the product associated with the advertisement attribute to the desirable subscriber (C3 L44-67, C6 L58-67).
26. As per new Claims 47 and 48, Boe discloses wherein, [computer program code for analyzing the matched data to identify a desirability of said subscriber, such that] if data of said subscriber information data store does not match an advertisement attribute, then identifying said subscriber as an undesirable subscriber in relation to a provider of said product (C6 L47-67, Matching Database/Page Generator, non-matching advertisements would be equivalent to identifying an undesirable subscriber in relation to a provider of said product).
27. As per **independent Claims 32-34**, Boe discloses a method (computer-readable medium, system) for utilizing information relating to a subscriber to identify said subscriber (C3 L23-43, profile generation and target marketing) comprising: receiving data from a plurality of programming (C3 L23-30, Internet survey system – demographic data, survey response, customer requests, customer) and advertising sources (C4 L30-38, business system); collecting subscriber data about a subscriber's use of a media delivery network, the collecting step comprising: i) identifying commands of interest from the subscriber (Fig.3-4a, C9 L-9-30, Customer accessing business system, accessing survey system, and answering demographic survey questions are all commands of interest); ii) forming event records that record at least the commands of interest and a time associated with the command (Fig.5a, C9 L23-27, C9 L55-61, answers to demographic survey questions are saved along with time stamp; time stamp necessary to determine last demographic data

update); receiving a subscriber attribute (C3 L23-43, survey results and demographics), the subscriber attribute comprising data about the subscriber; merging said data from a plurality of programming and advertising sources, said subscriber data, and said subscriber attribute to create a subscriber information data store (C5 L39-54, Matching Database Tables); matching data of said subscriber information data store with an advertisement attribute comprising product data about a product; and if data of said subscriber information data store matches an advertisement attribute, then identifying said subscriber as a desirable subscriber to receive a selected advertisement from a provider of said product (C6 L47-67, Matching Database/Page Generator, matches advertisements to customer profile information), or if data of said subscriber information data store does not match an advertisement attribute, then identifying said subscriber as an undesirable subscriber in relation to a provider of said product (C6 L47-67, Matching Database/Page Generator, non-matching advertisements would be equivalent to identifying an undesirable subscriber in relation to a provider of said product).

28. As per **independent Claim 35**, Boe discloses a method (computer-readable medium, system) for utilizing information relating to a subscriber to identify said subscriber (C3 L23-43, profile generation and target marketing) comprising: receiving data from a plurality of programming (C3 L23-30, Internet survey system – demographic data, survey response, customer requests, customer) and advertising sources (C4 L30-38, business system); collecting information about at least one subscriber's usage of media applications on at least one media device (Fig.3-4a, C9 L-9-30, Customer accessing business system, accessing survey system, and answering demographic survey questions

are all commands of interest), said media device supporting different applications invoked and controlled by a subscriber command (demographic and additional surveys), the step of collecting said subscriber's usage information further comprising: a) accepting a selected subscriber command (Fig.3-4a, C9 L-9-30, Customer accessing business system, accessing survey system, and answering demographic survey questions are all commands); b) determining an application identifier corresponding to a particular application to which the selected subscriber command is addressed (identifying survey system – demographic or additional); and c) creating an event record comprising: 1) the application identifier; 2) an identifier corresponding to the selected subscriber command, and 3) a time stamp that records the time of the occurrence of the selected subscriber command (Fig.5a, C9 L23-27, C9 L55-61, answers to demographic survey questions are saved along with time stamp; time stamp necessary to determine last demographic data update); receiving a subscriber attribute (C3 L23-43, survey results and demographics), the subscriber attribute comprising data about the subscriber (C3 L23-43, survey results and demographics); merging said data from plurality of programming and advertising sources, said subscriber usage information, and said subscriber attribute to create a subscriber information data store (C5 L39-54, Matching Database Tables); matching data of said subscriber information data store with an advertisement attribute comprising product data about a product (C6 L47-67, Matching Database/Page Generator); analyzing the matched data to identify a desirable subscriber to receive a selected advertisement from a provider of said product, said desirable subscriber having matched data of said subscriber information data store with said advertisement attribute (C6 L47-67, Matching

Database/Page Generator, matches advertisements to customer profile information – equivalent to identifying desirable subscriber).

29. As per Claim 36, Boe discloses wherein the step of receiving said subscriber attribute comprises receiving said subscriber attribute that identifies said subscriber as a consumer of said provider (C4 L58-60, application for product or service).
30. As per Claim 37, Boe discloses wherein the step of receiving said subscriber attribute comprises receiving said subscriber attribute that identifies a profession (C3 L23-27, income/income level – would offer equivalent demographic matching information) of said subscriber.
31. As per Claim 38, as understood be the Examiner, Boe discloses wherein the step of receiving said subscriber attribute comprises receiving said subscriber attribute that identifies a property ownership history of said subscriber (Fig.6b, vehicles).
32. As per Claim 39, Boe discloses wherein the step of receiving said subscriber attribute comprises receiving a questionnaire response (Survey Response) from said subscriber.
33. As per Claim 40, Boe discloses wherein the step of receiving said subscriber attribute comprises receiving a purchase of a product (C4 L58-60, receive application for service or product) by said subscriber.
34. As per Claim 41, Boe discloses wherein the step of receiving said subscriber attribute comprises receiving a purchase of a competitive product (Figs.4b-6b, spending history survey results – ex. type of vehicle) by said subscriber.

35. As per Claim 42, Boe discloses communicating (computer code/communications interface) the selected advertisement for said product associated with said advertisement attribute to said desirable subscriber (C3 L44-67, C6 L58-67).

Claim Rejections - 35 USC § 103

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. Claims 3 and 5 are rejected under 35 U.S.C. 103 as being unpatentable over Boe.

38. As per Claims 3 and 5, Boe fails to expressly show wherein said data from the plurality of programming and advertising sources comprises television programming data or duration information.

39. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber, as a desirable subscriber would be performed regardless of the type of content-access information used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using television programming data or duration information as the content-access information, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the content-access information does not patentably distinguish the claimed invention.

Response to Arguments

41. Applicant's arguments filed 3/13/2006, with respect to Claims 1-3, 5-13, 15-22, 32-44, 47, and 48, have been considered but are not persuasive. The rejection will remain as **FINAL**, based on the cited prior art.

42. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

43. The Applicant has made the argument that the prior art fails to teach or disclose subscriber information about a subscriber's use of the programming and advertising sources that includes i) a command of interest from the subscriber and an ii) an event

record that comprises a command of interest and a time associates with the command of interest.

44. However, Boe does disclose a customer accessing business system, accessing survey system, and answering demographic survey questions, which would all be equivalent to commands of interest (Fig.3-4a, C9 L-9-30). Furthermore, Boe discloses wherein the system saves demographic survey questions are along with time stamp; wherein the time stamp would be necessary to determine last demographic data update (Fig.5a, C9 L23-27, C9 L55-61).
45. The Applicant has made the argument that the prior art fails to teach or disclose analyzing the matched data to identify a desirable subscriber to receive a selected advertisement from a provider of said product, said desirable subscriber having matched data of said subscriber information data store with said advertisement attribute.
46. However, Boe does disclose a Matching Database/Page Generator, which matches advertisements to customer profile information (C6 L47-67), which would be equivalent to identifying desirable subscriber to receive a selected advertisement from a provider of said product.
47. The Applicant has made the argument that the prior art fails to teach or disclose collecting information about at least one subscriber's usage of media applications on at least one media device, said media device supporting different applications invoked and controlled by a subscriber command, the step of collecting said subscriber's usage information further comprising: a) accepting a selected subscriber command; b) determining an application identifier corresponding to a particular application to which

the selected subscriber command is addressed; and c) creating an event record comprising: 1) the application identifier; 2) an identifier corresponding to the selected subscriber command, and 3) a time stamp that records the time of the occurrence of the selected subscriber command.

48. However, as explained above, Boe does disclose a customer accessing business system, accessing survey system, and answering demographic survey questions, which would all be equivalent to commands of interest (Fig.3-4a, C9 L-9-30). Boe also discloses offering the customer a demographic survey or additional surveys (Fig.4b, equivalent to different applications). Furthermore, Boe discloses tracking a customers survey answers (application identifier/subscriber command - would be type of survey answered, with answers) and matching them up with appropriate advertising (C6 L47-67). Finally, Boe discloses wherein the system saves demographic survey questions are along with time stamp; wherein the time stamp would be necessary to determine last demographic data update (Fig.5a, C9 L23-27, C9 L55-61).

49. Finally, the Applicant makes the argument that the 103(a) rejection of claims 3 and 4 is improper, because the prior art of Boe fails to include every element of the pending claims.

50. However, Claim 4 has been cancelled by the Applicant; therefore, the argument is moot.

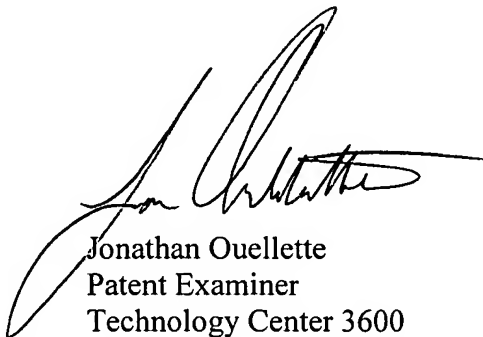
51. Furthermore, the 103 rejection of Claim 3 is based on the claim containing non-function descriptive data, wherein the descriptive material does not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031

(Fed. Cir. 1994). The Applicant has failed to appropriately address the outstanding rejection of Claim 3; therefore, the applicants arguments are moot.

Conclusion

52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
53. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
54. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

May 18, 2006



Jonathan Ouellette
Patent Examiner
Technology Center 3600